

In the United States
COURT OF APPEALS
for the Ninth Circuit

R. W. POINTER, doing business under the fictitious
name and style of Pointer-Willamette Co.,
Appellant,

vs.

SIX WHEEL CORPORATION, a corporation,
Appellee.

PETITION FOR REHEARING
AND BRIEF IN SUPPORT THEREOF

HAROLD L. COOK,

LEE R. SCHERMERHORN,

Cook and Schermerhorn,
717 Corbett Building,
Portland 4, Oregon,

Attorneys for Appellant.

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Comes now the appellant, R. W. Pointer, by his attorneys, and petitions the Court of Appeals for a rehearing under Rule 25 in the matter of the opinion filed September 27, 1949, in the above entitled cause. Appellant requests the rehearing on the ground that the opinion rendered by the Court is not dispositive of all the grounds of appeal, and that, even without questioning the correctness of the holding of the opinion as to each issue considered by the Court, there remain issues undecided by the Court which should be found in favor of appellant and which would result in the reversal of the judgment of the District Court.

Fundamental questions presented in appellant's brief on appeal have not yet been decided. Although the court has discussed the preliminary questions of invention and invention, it has not made any determination of the validity of the claims of the patent in suit; it has not applied the Knox claims in suit to defendant's structure to support a holding of infringement; and it has not disposed of defendant's contention of justification by reason of prior art.

Appellant also requests rehearing on the ground that the Court of Appeals has erred in its application of the law of the doctrine of equivalents, both as to the drawing of conclusions of equivalency of structure based on similarity of operation, and in applying the doctrine of equivalents without regard to the definitions of the claims or the limitations imposed by the prior art; and that the Court of Appeals has erred as to the weight to be accorded the prior art cited by defendant-appellant.

Appellant summarizes the points which he desires the Honorable Court of Appeals to consider, reconsider, and rule upon, as follows:

1. That claims 1, 2, 11, 15 and 17 of the Knox patent in suit are invalid in view of prior art cited by appellant which was not considered by the Patent Office during the prosecution of Knox's application for patent.

2. That claims 1, 2, 11, 15 and 17, construed so as to read upon defendant's alleged infringing device, are invalid for the reason that, construed in the same manner, they read upon the prior art, for example, letters patent

to Jeffries 174,533; Pratt 878,156; Naeser 1,414,147; Van Leuven 1,655,481; and British Patent No. 8262 to Spencer.

3. That the defendant's activities fall within the scope of the prior art patents No. 878,156 to Pratt; No. 1,534,458 to Mohl; British Patent No. 8262 to Spencer; and No. 1,655,481 to Van Leuven.

4. That the Court of Appeals has erred in its application of the doctrine of equivalents to find infringement based upon identity of function, and in its conclusion that identity of structure results from identity of function, without applying the doctrine of equivalents in the same way to compare Knox with the prior art, such as the patents to Pratt 878,156; Stebbins et al, No. 1,562,265; Van Leuven 1,655,481; Naeser 1,414,147; and British patent to Spencer 8262/1906.

5. That the Court of Appeals erred in applying the doctrine of equivalents to the functions, results and manner of operation of the Knox structure rather than in its proper role of interpretation of the patent claims.

6. That the Court has mistakenly considered the prior art to be "paper" art and has failed to accord due weight to the prior art under the erroneous belief that if it were impractical, it was not competent or operative.

Wherefore, appellant prays the Honorable Court of Appeals to grant a rehearing as requested in order that the above points which are material and essential to a proper disposition of this case may be resolved or clarified, and that the appellant may have a fair, just and

complete determination of this controversy, and that the public may know whether or not the Knox claims in suit are valid, and if valid, in what manner and to what extent.

Done at Portland, Oregon, this 26th day of October, A.D., 1949.

HAROLD L. COOK,
LEE R. SCHERMERHORN,
Attorneys for Appellant.

By

STATE OF OREGON)
) ss.
County of Multnomah)

I, Harold L. Cook, of the firm of Cook and Schermerhorn, attorneys for Appellant, hereby certify that I prepared the foregoing Petition for Rehearing in the above entitled cause, that in my judgment it is well founded in law and in fact, and that it is not interposed for purposes of delay.

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Of Counsel for Applicant

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BRIEF
IN SUPPORT OF APPELLANT'S PETITION FOR
REHEARING UNDER RULE 25

Points 1 and 2 stated for consideration by the Court
of Appeals in the Petition for Rehearing are as follows:

1. That claims 1, 2, 11, 15 and 17 of the Knox
patent in suit are invalid in view of prior art cited
by appellant which was not considered by the
Patent Office during the prosecution of Knox's ap-
plication for patent.

2. That claims 1, 2, 11, 15 and 17 construed so
as to read upon defendant's alleged infringing de-

vice, are invalid for the reason that, construed in the same manner, they read upon the prior art, for example, letters patent to Jeffries No. 174,533; Pratt, 878,156; Naeser 1,414,147; Van Leuven 1,655,481; and British Patent No. 8262 to Spencer.

Because of their similarity, these points are treated together herein, except as specifically noted.

The Court of Appeals has not passed upon appellant's Group I Specification of Errors and Points and Authorities thereon (appellant's Brief on Appeal, pages 14 and 16 respectively) to the effect that the claims of the Knox patent are invalid for the reason that, construed so as to read upon defendant's alleged infringing device, the claims also read, construed in the same manner, upon the devices of the prior art. The Court has not construed the Knox claims. The Court devoted 5 pages of its decision to preliminary considerations, 7 pages to the question of invention, and slightly over one page to the question of infringement, but nothing to the question of validity.

Thus far, the Knox improvement has been considered by the Court entirely apart from the actual patent grant defined by the claims. There may as well have been no claims at all so far as necessary to the decision of the District Court or the holding of this Court. Conclusions of validity and infringement must be based on the claims of the patent to determine what remains in the public domain and what has been appropriated to the exclusive use of Knox for the term of the patent.

It is axiomatic in the law *that claims which read on devices of the prior art are invalid for improper mo-*

nopoly. A patentee is not permitted to draft claims in terms such as to dominate the devices prior to him, and thereby relegate such prior devices to the position of infringing structures.

The purpose of the patent statutes is to carry out the provisions of Article I, Section 8 of the Constitution, "To promote the progress of science and the useful arts." A patent is a contract between the inventor and the people, represented by the government. The patent statutes require that the subject matter of such contracts be made definite and certain by including in the patent a claim "particularly pointing out and distinctly claiming the part, improvement, etc." which the inventor considers as his invention (Section 4888 R.S.) in order that the public will know definitely just what is contained in the contract for a seventeen year monopoly by an inventor and so may avoid infringement during the life of the patent. Unless an inventor's patent complies with statute, it is invalid; hence it must follow that a patent cannot be interpreted in such manner or with such looseness or disregard for the specific terms of its claims as to defeat the provisions of the patent statutes. Appellant here contends that the decision of the appellate court has sanctioned such a loose and improper construction of the Knox patent as to defeat the express provisions of the patent laws.

The patent statutes provide that the inventor upon making application for patent shall execute an oath that the invention *defined by the claims* of his patent is new and has not been known or used or published before

his invention or discovery thereof. Further, the United States Patent Office provides an examination system to make a search of the prior art and require that the claims of the patent be limited to that which is new before the patent contract can be executed between the inventor and the people as represented by the Patent Office. There is no requirement that the specification and drawings of the patent be limited to that which is new, because the new part or improvement could not be understood without reference to that which is old. Therefore, the greater part of every patent, and this is especially true of the Knox patent, consists of a disclosure of that which is old and including the new part or element defined by the claims of the patent contract.

The object of any invention or improvement is to solve some problems in an art. These objects are usually set out in the beginning of the patent specification and state the problem as it existed prior to the invention disclosed in the patent. Each of the many different patents in any particular classification of a specific art is distinguished from the other patents in that art by the means employed to solve the problem. The Knox patent is such a patent. Knox's patent contract with the people for a seventeen year monopoly embraces and is limited to certain specific mechanical devices for accomplishing the same result and function sought by numerous other patentees prior to the Knox invention. Eighteen prior patents are cited by appellant on Appeal. The District Court, however, and now the Appellate Court, has disregarded the devices disclosed in prior

published patents of other patentees for attaining the same results, and both courts base their decisions on infringement on the mere holding that the defendant's Feather Ride structure also seeks to accomplish the desired result set out in the *objects* of the Knox patent.

Neither the District Court nor the Appellate Court actually found that defendant's structure responded to the definition of the Knox invention *as defined by the claims* of the Knox patent, but merely drew this inference because the same desirable result was accomplished. This desirable result, however, as is usually the case, was well recognized in the art, and each of the eighteen patents was granted for a particular mechanism for accomplishing the result. It should be self-evident that, were this fact not true, the Patent Office would have issued only one patent on a tandem axle suspension, and this long before Knox's improvement. The Knox improvement would have had to be many years earlier in order to conclude that the patentee was entitled to dominate all other means for performing the same desired function and result, and to justify disregarding the *claims* which define the terms of the contract executed between the inventor and the people of the United States. Neither the District Court nor the Appellate Court has explained to the people or to the appellant how the specific terms of Knox's contract with the people (the claims) apply to defendant's structure. It is most urgently contended that appellant is entitled to know just what means and structures are covered by the terms of Knox's patent.

It was clearly established in the early days of our present patent system in the celebrated case of O'Reilly v. Morse, 56 U.S. (15 How.) 61, 105 et seq. (1853), that a patentee, having devised a particular means for accomplishing a desired result, could not obtain a patent on the function or result itself. This is sound logic, because the desirability of the function or result was admittedly well recognized prior to the invention. Hence the Patent Office did not grant Knox a patent on the function or object of the invention, which existed before the improvement was made, but on a specific means for performing the function, and any holding that Knox's claims are of sufficient scope to cover the desired function or result must be clearly contrary to statute and in conflict with the constitutional mandate.

The "doctrine of equivalents" has been evolved to provide a certain amount of elasticity in the patent claims and to do equity to a patentee where his patent attorney has unduly restricted his claims. The doctrine of equivalents in effect amounts to judicial reformation of the claim, but in equity it must not violate the right of the people to enjoy the free use of that which is already in the public domain. Thus, under the doctrine of equivalents, it is true that the specific terms of the Knox claims may be given broader interpretations than the strict dictionary definitions, *but only to the extent that these interpretations do not take away the enjoyment of some right to which the public is entitled.*

The doctrine of equivalents cannot extend to result or function, because that would both take away from

the people the enjoyment of other means which have been in the public domain and remove the incentive for devising new means.

Before proceeding with the argument, appellant desires to point out that even though the Court has found that the Knox patent involves invention, such opinion is not conclusive on the issue of validity. Even though it be conceded that Knox made an invention, the claims must nevertheless correctly define that invention in order for the patent to be valid. If the claims are drawn so broadly that they read on the prior art, they are invalid and the patent is unenforceable even though it disclose meritorious invention. In such a case, the patent may be saved only by restricting the interpretation of the terms of the claims to the disclosure of the drawings and specifications.

Appellant believes that neither the District Court nor this Court has given a proper measure of attention to the claims of the Knox patent, either for the purpose of the definition of Knox's invention, or for the purpose of comparing defendant's Feather Ride structure in terms of the Knox invention as defined by his claims. These questions, which are fundamental in any patent infringement case, have been entirely obscured by talk about problems of the art, results accomplished, contribution to the art, methods of operation, and *similarity of operation* of the Knox invention and the defendant's structure.

The Knox patent may as well have had no claims at all so far as necessary to support any findings made by

the District Court or the opinion rendered by the Court of Appeals. True, the District Court in Findings of Fact 13 makes the bald declaration, which is no more than a formal conclusion of law, that the defendant's structure infringes claims 1, 2, 11, 15 and 17 of the Knox patent. Moreover, attention is particularly invited to Finding 9 of the District Court (Tr. 20) to the effect that the defendant's structure "embodies each and every element of *the invention*" of the Knox patent. Infringement must be *of the claims* and not of that intangible and undelimited entity referred to as the invention. The rule was stated by the Supreme Court in *Smith v. Snow*, (1935), 294 U.S. 1, 11; 24 U.S.P.Q. 26, 30, as follows:

"* * * the claims of the patent, not its specification, measure the invention. Paper Bag Patent Case, 210 U.S. 405, 419; *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116; *Winans v. Denmead*, 15 How. 330, 343."

Smith v. Snow has been cited with approval in *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938), 37 U.S.P.Q. 466; in *Saco-Lowell Shops v. Reynolds*, C.C.A. 4, (1944), 141 F. (2d) 587, 593-595, 61 U.S. P.Q. 3, 9; and in *Universal Oil Products Co. vs. Globe Oil & Refining Co.*, 322 U.S. 471 (1944).

Defendant's structure is a different combination from the plaintiff's and was never contemplated in plaintiff's inventive concept. There is no semblance of copying of the plaintiff's structure, which is always necessary before the doctrine of equivalents is to be applied. Obviously, the defendant's Feather Ride structure does not look

like the Knox patent. The arrangement of parts is entirely different, which alone should be sufficient to remove all doubt of infringement of claims defining an invention which resides in the novel combination of parts. Were there to be identity of operation, there should be mutuality of operation. Exhibit 75 clearly shows that "the axle of the attachment" in the Feather Ride suspension is added to the vehicle by use of a front walking beam. This front walking beam is not interchangeable with nor does it perform the same function as does the rocker arm in the Knox construction. Moreover, it is not pivoted intermediate its ends on hanger brackets affixed to the vehicle frame. This showing constitutes further proof, if such were needed, that the combination of parts employed in defendant's Feather Ride structure is a different combination of parts than is employed in the Knox patent, and that the two combinations are not identical in operation.

Appellee has created the impression that since the prior art patents cited by appellant do not *look like* the device illustrated in the drawings of the Knox patent, they cannot possibly anticipate (For example, see page 15 of appellee's brief, where it discusses structural differences; page 23 where it compares the drawings of Knox and Fageol). Appellee insists that the bogey disclosures are non-analogous art (Page 20, appellee's brief). Appellee overlooks the purpose of prior art patents, even if they are non-analogous art. That purpose is to show a structure defined *by the claims of the patent* in suit. It is immaterial whether the prior art

devices look like Knox's drawings. He did not patent the drawings! Appellee points out how Knox's device differs from the prior art, but he did not limit his claims to distinguish from the prior art. Remember—it is the claims that measure the invention—not the drawings.

If Knox's claims were limited to define only the device illustrated in his drawings, his comparison with the prior art might be pertinent to the issue of anticipation. But such is not the case.

It is immaterial whether these prior art devices were operative or successful, if they show the elements defined in Knox's claims. Despite all appellee's attempts to becloud the issue, the sole question for determination by the Court is: "*Can the claims of Knox be read on the devices of the prior art patents?*" If Knox made any contribution to the art, he failed to define it, either deliberately or inadvertently, in terms which avoid the prior art, and his patent reads on the prior art and dominates all structures resembling the prior art. Defendant-appellant has a right to take from the prior art that which is disclosed therein, but under the Knox patent, construed in the manner of the District Court's findings, and the Honorable Court of Appeal's opinion, he is precluded from such right.

Appellant has selected the prior art patents to Jeffries, No. 174,533; to Pratt, No. 878,156; to Naeser, No. 1,414,147; and to Van Leuven, No. 1,655,481, and the British patent to Spencer, No. 8262, to illustrate the reading of the claims on the prior art, as well as the manner of reading the claims on Knox's own disclosure

and the Feather Ride structure. In Appendix I appellant reads Knox claim 1 on the selected patents as typical of the group of claims consisting of claims 1 and 15, and in Appendix II appellant reads Knox claim 2 as typical of the group consisting of claims 2, 11 and 17. If the Court desires, appellant will read all the claims in the manner of either claim 1 or claim 2.

If appellee objects that the car trucks of Jeffries and Spencer are different from the six wheel attachment for motor vehicles of the Knox patent, let it be reminded that the trailer of defendant's structure, which is neither a six wheel attachment nor a *motor* vehicle, is likewise different from the six wheel attachment of Knox for a motor vehicle, and more nearly resembles Spencer's car truck than it does Knox's attachment.

If the appellee objects that the vehicle chassis of Naeser is not a six wheel attachment, let it be reminded that neither is Feather Ride a six wheel attachment, but a four wheel semi-trailer which more nearly corresponds to the showing of Naeser than it does to the six wheel attachment of Knox. The fact that these structures are different from the Knox six wheel attachment should make it all the more difficult to read the claims thereon. The fact that the claims can be read on bogey car trucks either confirms all the more appellant's contention as to their undue breadth and invalidity, or establishes that there is not so much difference between the railroad bogey art and the six-wheel attachment art as appellee would have us believe, or both.

Before proceeding with a reading of the claims, appellant asks the Court to bear in mind that if and when the claims can be so readily read upon the prior art, they are invalid under the undisputed rules of law:

(1) That the claims measure the invention, and that a finding of infringement must be predicated on a finding of violation of the claims either in their express terms or with such latitude of interpretation and amplification as is permitted by the doctrine of equivalents;

(2) That a claim which reads upon the prior art encompasses more than the patentee may claim as his invention;

(3) That an alleged invention which is not defined (by claims) in terms so as to avoid reading upon the prior art is anticipated by such prior art and cannot properly be granted the protection of U. S. Letters Patent; and

(4) That the same restrictions of interpretation placed upon claims to save them from reading on the prior art must also be placed upon the claims when reading them on the alleged infringing device.

Inasmuch as comparison of the manner of reading of the claims on the different structures is facilitated by arranging the readings in adjacent columns, appellant has prepared the reading of claim 1 in Appendix I, and the reading of claim 2 in Appendix II. Reference is made thereto.

Appellant asks the Court to point out wherein he is in error, either in law or in fact. Appellant asks the

Court to read the claims first on Feather Ride, and then on the prior art, and thus note that the claims read on British patent No. 8262 to Spencer as easily as they read on Feather Ride, and that they read on Jeffries, Pratt, Naeser and Van Leuven easier than they read on Feather Ride. For a comparison of claim 11 with Pratt and Feather Ride, see pages 197-202 of the Transcript of Record.

Feather Ride Follows the Prior Art

The third point stated in the Petition for Rehearing is:

3. That the defendant's activities fall within the scope of the prior art Patents No. 878,156 to Pratt; No. 1,534,458 to Mohl; British Patent No. 8262 to Spencer; and No. 1,655,481 to Van Leuven.

The Court has not passed upon the defense stated on pages 39, 43-47 of Appellant's Brief on Appeal that "Defendant's activities fall within the scope of the prior art." If this be so, there can be no infringement. It is clearly shown therein how defendant's Feather Ride structure and the structures of the patents to Pratt, Spencer and Mohl are substantially identical arrangements of parts. The only differences are in elements which are shown by the record to be equivalents.

It is appellant's contention that the Feather Ride structure follows the teachings of the prior art rather than the teaching of Knox, both as to the arrangement of parts and in using a rubber cushion, as shown by

Fageol 1,692,891, to obtain the necessary flexibility instead of a universal joint. It naturally follows that if defendant's structure is taught by the art prior to Knox, it is not subject to domination by the Knox patent. Appellant asks the Court to rule on this point presented on page 43 of his Brief on Appeal and point out wherein the defense fails.

This point is really a corollary of the first point for consideration on rehearing. By proving that Feather Ride is more similar to the prior art than it is to Knox, it is proved that the claims of Knox, construed so as to read on Feather Ride, read also on the prior art and are therefore invalid.

It has been established in this case that a leaf spring, a pivoted universal joint, and a rubber bushing are all broadly equivalents for the purpose of providing relative universal movement between parts connected by these members. Obviously, however, each such universal connecting means is different from the other, and no doubt each has its advantages and each has its disadvantages. Therefore, specific invention may reside in the specific selection of any one of these universal connecting means. But when speaking of generalities, it is as fair to say that Feather Ride copied from Van Leuven or Spencer as it is to say that Feather Ride copied from Knox.

The Feather Ride structure more nearly resembles and is more closely copied from the railroad bogey art, as exemplified by British Patent No. 8262 to Spencer, than it resembles or is copied from the Knox patent. The Feather Ride structure is the equivalent in all re-

spects of the British patent referred to (Tr. 147). Appellant on pages 44-45 of his Brief on Appeal presented a detailed comparison of Feather Ride with Spencer. It will be seen from the comparison that all the elements of the Feather Ride structure, *and the same arrangement of parts* are found in the British patent to Spencer, and that the Feather Ride structure may more nearly be said to be copied from the British patent to Spencer than it can be said to have been copied from Knox. Is the defendant to be penalized and to be declared an infringer when he appropriates devices and ideas existent in the art, long before Knox, which are presumably free to the public? Or, conversely, is the Knox patent to be allowed to dominate structures made in accordance with the teachings of the prior art? These are the results which will obtain if the opinion of the Honorable Court of Appeals is allowed to stand.

The big difference that exists between the Knox patent and either the defendant's Feather Ride structure or the British patent is that the element designated as a rocker arm in the Knox patent is connected at *an end thereof* with the attachment axle, whereas the walking beam connected to the axle which must be regarded as the attachment axle in either the Feather Ride structure or the British patent has its one end pivotally connected to the frame of the vehicle, has the other end connected to the free end of the rear spring, and has its connection with the attachment axle at the middle portion thereof. Knox does not disclose such a structure, and he is not entitled to construe his claim by the doc-

trine of equivalents to include such a structure, because if he does so then it reads squarely on the British patent. Any objection to the showing in Spencer that it does not provide a radius arm or the control exercised by a radius arm is met by recognition of the fact that the function of a radius arm is supplied by the vertical guide boxes. In fact, the resemblance of the Feather Ride structure to the Spencer patent is emphasized by the fact that the suspension in the Feather Ride structure between the rear beam and the frame is accomplished by means of the trunnion and guide box in the same manner as the vertical guide box in the Spencer car trucks holds the axle in fixed longitudinal relation to the vehicle frame.

The Doctrine of Equivalents

The Fourth and Fifth points set out in Appellant's Petition for Rehearing are:

4. That the Court of Appeals has erred in its application of the doctrine of equivalents to find infringement based upon identity of function, and in its conclusion that identity of structure results from identity of function, without applying the doctrine of equivalents in the same way to compare Knox with the prior art, such as the patents to Pratt 878,156; Stebbins et al, 1,562,265; Van Leuven 1,655,481, Naeser 1,414,147, and British patent to Spencer 8262/1906.

5. That the Court of Appeals erred in applying the doctrine of equivalents to the functions, results and manner of operation of the Knox structure rather than in its proper role of interpretation of the patent claims.

A considerable portion of appellant's argument is common to both points, so the points are herein treated together.

First of all, let it be made clear that appellant has no quarrel with certain propositions and conclusions developed in this case as to equivalents. Appellant agrees that a universal joint, a leaf spring, and a rubber bushing are equivalent elements for providing universal relative movement in varying degree between parts connected by such elements. Appellant agrees that a leaf spring may be the equivalent of a rocker arm. Appellant agrees that the combination of a beam and a nest of coil springs is the equivalent of a leaf spring. Proof of equivalency of particular elements is established from the knowledge of the prior art—not by their comparison for the first time in an alleged infringing device and in the patented device. It has been established in the case at bar that equivalency of the above named elements was known before the time of the Knox patent. Therefore, any equivalency existing between Knox and Feather Ride, so far as these elements are concerned, also exists between Knox and the prior art, and Knox is not entitled to dominate a structure merely because it employs such elements which were already known to be equivalents prior to Knox. The claims of the Knox patent should be restricted in scope to avoid the prior art rather than enlarged by the doctrine of equivalents to include both the defendant's Feather Ride structure and the prior art.

Appellant further points out that proof of the equivalency of the elements named above does not prove

equivalency of the combinations in which they are used. Vice versa, proof of similarity of function and operation of two combinations of elements does not prove equivalency of all the elements in the combination, because the arrangement of elements in the combination may be entirely different, and in patents for mechanical combinations a specific arrangement of parts is itself an element of the combination. Appellant's objection to the opinion in this case is that the doctrine of equivalents has been applied to different combinations of old elements merely because those combinations accomplished the same results, and without regard to the limitations contained in the claims, and also without regard to whether the prior art limited the invention as defined in the claims.

It is well established that a claim for a mechanical structure is not infringed by each competitive device that accomplishes the same result. If this were so, one may as well write claims as "means for accomplishing a stated function". The doctrine of equivalents must proceed from the claimed definition and not from proof as to similarity of operation and function of the devices. It is in this respect that the trial court and the Court of Appeals have fallen into error. The decisions cited by the Court in its opinion, while having verbiage which appear to support the conclusion of the Court, will be found upon analysis to recognize either expressly, or impliedly in view of the merits of each case, that the doctrine of equivalents is at all times to be limited by the prior art.

In the instant case, the Court has found that there was identity of function between the operation of Knox and the Feather Ride structure, and then concluded therefrom, first, that there was identity of structure, and, second, that infringement necessarily results therefrom. It is submitted that such application of the doctrine of equivalents is laid upon too broad a basis, even without regard to the prior art. It is repugnant to logic and fact that identity of operation and identity of function necessarily result in identity of structure. If this were so, all devices which accomplish a given result would infringe all patents which teach a means of obtaining that result. Such reasoning and application of the doctrine of equivalents overlooks entirely the infirmity of, and repugnance attached by the patent law to, claims which define a structure by a statement of its function. For the purpose of such application of the doctrine of equivalents, the claims may as well have been defined in the terms stated in the object of the patent. The landmark case in holding that claims may not be defined in such broad scope as to be nothing more than the statement of objects is *O'Reilly v. Morse*, 56 U.S. (15 How.) 61, 105 et seq. (1853). It will be recalled that that case involved Morse's invention of the telegraph. The Supreme Court held invalid a claim of the patent drawn in the following terms:

"Eighth: I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I

call electromagnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer."

There was no dispute that the claim as recited defined Morse's invention, but the objection to the claim was that because it was stated in terms of results, rather than apparatus, it defined more than the apparatus which he had invented. Morse's invention, of even such a basic device as the telegraph, was limited to apparatus.

The principle of law that functional claims are improper has been followed by the Supreme Court in numerous cases up to the present time. In *Holland Furniture Company v. Perkins Glue Co.*, 277 U.S. 245 (1928), the Court stated, on page 256:

"But an inventor may not describe a particular starch glue which will perform the function of animal glue and then claim all starch glues which have those functions."

The principle is also followed in *General Electric Co. v. Wabash Appliance Corp*, 304 U.S. 364 (1938); 37 U.S. P.Q. 466, 468, the court stating:

"The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights."

In *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 581 (1863), the Supreme Court noted how a claim might be expanded or contracted at will on the strength of "pure logic". In discussing the claim which contained the words "substantially as described", the court stated:

"In a contest with the previous patent, the last words can be called in to qualify the first, and narrow it down to the peculiar combination of devices described; while, in assaulting a new combination, for the purpose of suppressing it, the claim may be stretched to cover every machine having a 'concave vibrating surface' by calling all the other parts 'equivalents'."

The situation thus described by the Supreme Court is quite similar to the result being achieved in the instant case.

Other cases barring the functional claim are *Universal Oil Products Co. v. Globe Oil and Refining Co.*, 322 U.S. 471; 61 U.S.P.Q. 382 (1944); and *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1; 67 S. Ct. 6; 71 U.S.P.Q. 175 (1946).

In the latter case, which incidentally reversed the decision of the Ninth Circuit Court of Appeals reported in 146 F. (2d) 817 cited by the Court of Appeals in its opinion in this case, the Supreme Court states:

"Patents on machines which join old and well-known devices with the declared object of achieving new results, or patents which add an old element to improve a pre-existing combination, easily lend themselves to abuse. And to prevent extension of a patent's scope beyond what was actually invented, courts have viewed claims to combinations and improvements or additions to them with very

close scrutiny. Cf. *Lincoln Engineering Co. v. Stewart Warner Corp.*, 303 U.S. 545, 549-51 [37 USPQ 1, 3-4]. For the same reason, courts have qualified the scope of what is meant by the equivalent of an ingredient of a combination of old elements. *Gill v. Wells*, 22 Wall. 1, 28, 29. *Fuller v. Yentzler*, 94 U.S. 288, 297, 298. It is quite consistent with this strict interpretation of patents for machines which combine old elements to require clear description in combination claims. This view, clearly expressed in *Gill v. Wells*, *supra*, is that

‘Where the ingredients are all old the invention * * * consists entirely in the combination, and the requirement of the Patent Act that the invention shall be fully and exactly described applies with as much force to such an invention as to any other class, because if not fulfilled all three of the great ends intended to be accomplished by that requirement would be defeated. * * * (1.) That the Government may know what they have granted and what will become public property when the term of the monopoly expires. (2.) That licensed persons desiring to practice the invention may know, during the term, how to make, construct, and use the invention. (3.) That other inventors may know what part of the field of invention is unoccupied.

‘Purposes such as these are of great importance in every case, but the fulfillment of them is never more necessary than when such inquiries arise in respect to a patent for a machine which consists of a combination of old ingredients. Patents of that kind are much more numerous than any other, and consequently it is of the greatest importance that the description of the combination, which is the invention, should be full, clear, concise, and exact.’ *Gill v. Wells*, *supra*, at 25-26.”

* * * * *

“Under these circumstances the broadness, ambiguity, and overhanging threat of the functional

claim of Walker become apparent. What he claimed in the court below and what he claims here is that his patent bars anyone from using in an oil well any device heretofore or hereafter invented which combined with the Lehr and Wyatt machine performs the function of clearly and distinctly catching and recording echoes from tubing joints with regularity. Just how many different devices there are of various kinds and characters which would serve to emphasize these echoes, we do not know."

* * * * *

"Yet if Walker's blanket claims be valid, no device to clarify echo waves, now known or hereafter invented, whether the device be an actual equivalent of Walker's ingredient or not, could be used in a combination such as this, during the life of Walker's patent."

The most grievous error on the part of the Court of Appeals in its application of the doctrine of equivalents relates to the matter of comparing the results and operation of the defendant's Feather Ride structure with the disclosure of Knox without also comparing the results and operation of the prior art devices, both with defendant's Feather Ride structure and the disclosure of Knox. The finding of the Court that because the elements of the defendant's structure "combine to produce the same results—flexibility, equal distribution of the load, avoidance of excessive wear—which the patent in suit first taught the art." is solely a finding of identity as to function and not as to identity of structure as stated by the Court. Furthermore, *it is not first taught* by Knox.

When the doctrine of equivalents is employed, as in the present case, to base a conclusion of identity of

structure upon a finding of identity of function and operation, it acts as a boomerang, because it is only fair to examine the prior art for identity of structure under the same test of equivalency. The test reaches backwards into the art as well as forwards to an alleged infringement. If Feather Ride is equal to Knox on the ground of successful operation and similarity of function, so is Stebbins et al 1,562,265 or Van Leuven 1,655,481 equal to Knox. By the reasoning applied by plaintiff and the Court, to-wit, that if the same results are obtained—flexibility, equal distribution of the load, avoidance of excessive wear—then there is identity of structure on the ground of equivalency—by this same reasoning, it must be found that there is identity of structure between the Knox patent and the Stebbins et al patent 1,562,265, because that is an operative device employed by the Utility Trailer Co. even at the present time for the manufacture of six wheel trailers according to the testimony of Mr. Knox (Tr. 105-106). It follows then that the Knox patent is anticipated by Stebbins et al patent to the same extent and for the same reasons that Knox is infringed by the Feather Ride structure.

Similarly, Van Leuven No. 1,655,481 can be shown to be the equivalent of Knox. Appellee, on page 36 of its brief, asserts that the Van Leuven patent is a rigid type structure. Such assertion is in conflict with Van Leuven's own description, prepared by his patent attorneys, Lyon & Lyon, who were the attorneys for the Knox patent and are the attorneys for plaintiff-appellee.

Van Leuven's claim 11 specifies in the final clause "the springs (29) being mounted for independent equalization on opposite sides of the frame." In claims 10 and 12, these springs of the attachment are referred to as "levers" in similar clauses: "said levers being mounted for independent equalization on opposite sides of the vehicle." This "independent equalization" obviously refers to the "up and down motion of the auxiliary wheels 43" referred to on page 3, line 72. Thus the concept of independent equalization of the levers or rocker arms on opposite sides of the frame to maintain the auxiliary wheels in engagement with an irregular surface roadway is a common inventive concept in both Van Leuven and Knox patents, but the record shows that Van Leuven is prior to Knox.

Feather Ride follows the teaching of Van Leuven, not Knox, in using a cushion or spring element to obtain the necessary flexibility, instead of a universal joint. Let Knox be restricted to a double pivot universal joint which he shows, and not be interpreted to cover the resilient element type of universal taught by Van Leuven. Van Leuven has expired and should be available for free public use.

See also on page 1 of the patent to Naeser (Tr. 525), the very fine statement of operation and the description of the means provided for obtaining relative universal movement of each of the wheels independently of the others, and of the universal connecting means for connecting the wheel to the axle. Both Van Leuven and Naeser must therefore be the equivalents of Knox. Be-

ing prior to Knox, Knox is invalid unless restricted to his specific disclosure. Being prior to Knox, they are in the public domain and defendant's structure which operates to accomplish the same results as Van Leuven or Naeser is free from domination by Knox.

In view of the foregoing exposition, it is believed that it is now clear that the doctrine of equivalents should be applied only in consideration of the structures defined in the claims—not to similarities of function and theories of operation. Even if we were to consider the Knox invention to be as defined by the District Court in Finding 7 then we do not find in the defendant's alleged infringing structure an essential element of the combination, namely: "which rocker arms are connected at their opposed ends through the provision of the universal joint with one of said axles". The term "opposed ends" used in Finding 7 is not used in the patent, but it must refer, in the light of the context of Finding 7, to the ends of the rocker arms which are not connected with the vehicle spring. This, then, makes it necessary that we consider the front beam of Feather Ride as the rocker arm, for otherwise, if the rear beam were considered to be the rocker arm, neither of its ends is connected to the vehicle spring. By no fair reading of the definition of the invention contained in Finding 7 can it be said that the opposed ends of the rocker arms in defendants' Feather Ride structure are connected through the provision of a universal joint with one of said axles. Nor can we find an element in the defendant's structure which is equivalent to this very essential

element of plaintiff's patent. Neither of the opposed ends of the front walking beams in defendant's Feather Ride structure is connected, with or without a universal joint, to one of said axles. It is true that both of defendant's Feather Ride walking beams are connected to each of the two axles through a rubber cushion, *but not at their "opposed ends"* as the term has been defined.

It was necessary to include in the definition of the Knox invention the language "which rocker arms are connected at their opposed ends through the provision of the universal joint with one of said axles" in order to define the essence of the new combination invented by Knox and to distinguish from the prior art. As shown in the readings of the claims, Jeffries, Pratt, Naeser, Van Leuven, and Spencer each have a rocker arm connected to one axle respectively of the device through the provision of a universal joint (or its equivalent). It is only by a strict reading of the limitation quoted above that the Knox patent avoids reading on the prior art.

Appellant returns to *one proposition which is fundamental in a fair decision of this case, and that is that the claims should be read upon the defendant's Feather Ride structure in order to establish infringement. But the claims have not yet been so read either by the District Court or the Court of Appeals.* On the contrary, the reading of the claims has been overlooked under the erroneous reasoning that since the operation of the devices is similar or identical, there must be infringement.

Appellant respectfully repeats that it is the claims which measure the invention, and that the proper application of the doctrine of equivalents is only for the purpose of broadening the scope of a particular term or element in a claim to include an equivalent term or element. The doctrine of equivalents should not be applied to the combination defined in the claim as a whole, which is what is being done in the present case.

The Knox invention is for a combination, and should be limited to that combination and not extended to all combinations which produce the result, unless that result and the structure required to accomplish that result can be defined in terms which exclude the prior art. Appellant's device more closely resembles the prior art than it does the Knox patent, so that when Knox attempts to enlarge his scope to include the appellant's structure, he necessarily encroaches upon the prior art. The Knox claims must therefore not only be read upon the defendant's structure in order to establish infringement, but also be found not to read, construed in the same manner upon the prior art. The claims must likewise be read in terms of the structural elements defined therein and not in reference to the functions described in the Knox specification or by plaintiff's attorneys. This is a case involving a machine having definite structures and defined in structural terms. Function may be looked to only to determine whether a particular element may be substituted for another, and not as to whether one arrangement of all the elements may be substituted for another arrangement.

Paper Nature of the Prior Art

The sixth point stated in the Petition for Rehearing is:

6. That the Court has mistakenly considered the prior art to be "paper" art and has failed to accord due weight to the prior art under the erroneous belief that if it were impractical, it was not competent or operative.

The question to be resolved is as to whether the art cited by defendant-appellant and compared with the Knox claims, as above, is proper to be considered and entitled to any weight. Otherwise, the Court may linger upon the impression that the patents relied upon by appellant are improper references, even for disclosing the subject matter defined by the Knox claims.

The appellee has attempted to discredit the patents introduced by defendant as evidence of prior art by claiming that they were impractical or merely "paper" art. The Court has apparently been influenced by the appellee, as evidenced by the statement on page 13 of the opinion that: "The art, it should be observed, is chiefly 'paper' art."

Defendant's witness, Dr. Clark, read the claims of Knox on British patent to Spencer, No. 8262 (Tr. 166-171); on the patent to Smith 1,111,924 (Tr. 172-173); on the patent to Collard, 1,131,118 (Tr. 173-175); on the patent to McCracken 1,527,987 (Tr. 175-176); on the patent to Mohl 1,534,458 (Tr. 176-177, 210-211); on the patent to Jeffries No. 174,533 (Tr. 193-194); on the

patent to Pratt, No. 878,156 in comparison with a reading on the Feather Ride structure (Tr. 197-202); on the patent to Brillie, No. 915,733 (Tr. 202-206); on the patent to Furlong 1,436,031 (Tr. 208-210); on the patent to Van Leuven 1,655,481 (Tr. 214-215); and on the patent to Fageol 1,692,891 construed in the same manner as construed to read on Feather Ride (Tr. 215-217). None of these patents were admitted or proved to be impractical.

Appellant pointed out at the top of page 12 and at the bottom of pages 13-14 of his Reply Brief that the Stebbins and Van Leuven Patent No. 1,562,265 (Exhibit No. 52—Tr. 542) was a successful, operating structure. This patent has been extensively exploited by the Utility Trailer Manufacturing Company throughout its life, and, after the discontinuance of manufacture in accordance with the Knox patent in 1928 or thereabouts, trailers manufactured by the Utility Trailer Manufacturing Company have corresponded more to the Stebbins and Van Leuven Patent No. 1,562,265 than they did to the Knox patent, according to Mr. Knox's testimony (Tr. 105-106). Patent 1,562,265 is, therefore, not a paper patent.

Appellant pointed out on pages 12 and 13 of his Reply Brief that the Van Leuven Patent No. 1,655,481 (Exhibit 56—Tr. 547) was a successful, operating structure. Further evidence of the successful commercial application of this patent is shown by plaintiff's Exhibit No. 77 (Tr. 447-448). It will appear therefrom that the District Court for the Southern District of California,

in Civil Action No. 1650-Y, Six Wheel Corporation and Erna Agnes Van Leuven v. Fager Corporation and J. M. Hellen, entered a judgment decreeing that Letters Patent No. 1,655,481, together with the Knox patent in suit, and each and every claim thereof, were good and valid in law and had been infringed by the Fager corporation and J. M. Hellen jointly. Patent No. 1,655,481 must have defined a practicable and commercially successful structure, or it would not have been infringed, and the plaintiff in that case, who is the same plaintiff in this case, would not have needed to be concerned if others were manufacturing only impractical devices under the patent. Appellant submits that plaintiff's Exhibit No. 77 is evidence of practical use of Van Leuven Patent No. 1,655,481, and that such patent may not, therefore, be dismissed by the appellee and the Court as impractical or a "paper" patent.

Furthermore, the law is clear as appellant has shown on pages 10 and 11 of his Reply Brief that United States patents, whether actually reduced to practice or not, and whether impractical or not, are competent, even if inoperative, to be considered as prior art for the inventive concepts and structures shown therein. Actually, appellee's implication that the prior art references are inoperable is without evidentiary support. The most adverse statement about any of the references is that they may have been impractical (Tr. 252, 253, 254). No criticism was made of the patent to Jeffries 174,533, the patent to Pratt, 878,156, the patent to Naeser 1,414,147, the patent to Stebbins et al 1,562,265, the patent to Van

Leuven 1,655,481; British patent to Spencer 8262. On the other hand, the fact of patenting of the prior art references is evidence of their operativeness. *Metropolitan Engineering Co. v. Coe*, 64 App. D.C. 315; 78 F. (2d) 199; 25 U.S.P.Q. 216.

In conclusion, appellant asks one chief consideration—that the Court read the claims of the Knox patent, first on Feather Ride, and then on the prior art, and point out to appellant wherein the claims do not read on the prior art in the same manner that they read on Feather Ride. Only then can it be said that the claims are valid and infringed.

Respectfully submitted,

HAROLD L. COOK,

LEE R. SCHERMERHORN,

Attorneys for Appellant.